



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,114	11/25/2003	Michael Z. Hoemann	SPV-048.02	4865
25181	7590	08/19/2005	EXAMINER	
FOLEY HOAG, LLP PATENT GROUP, WORLD TRADE CENTER WEST 155 SEAPORT BLVD BOSTON, MA 02110			DESAI, RITA J	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,114

Applicant(s)

HOEMANN, MICHAEL Z.

Examiner

Rita J. Desai

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>8/17/05</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

DETAILED ACTION

The Finality of the Action has been withdrawn.

The examiner has found some art requiring New Ground of Rejection.

Claims pending 1 and 92.

During an Interview with Mr Gordon on 8/17/05 before the new grounds of rejection were found, the applicants attorney agreed to some amendments.

1. For the definition of R1 (claim 1) to be optionally substituted carbocyclic aryl to insert a 6 membered aromatic ring containing no hetero atom . [this was being done in order to avoid introducing new matter.
2. Delete R3 and R4 may be connected through a covalent bond . [Non-elected matter drawn to group III. See the restriction]
3. R5 phenyl substituents to be limited to Halogen, alkyl and alkoxyl.

These would overcome the enablement rejections given previously.

When examiner did an updated search she found art, hence the following New ground of rejection.

New Ground of Rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

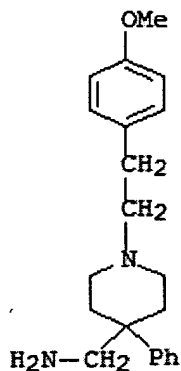
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1625

Claims 1 and 92 are rejected under 35 U.S.C. 102(b) as being anticipated by Joseph DeGraw et al 1967 Histamine Releasers..

The reference discloses the compounds of the structure



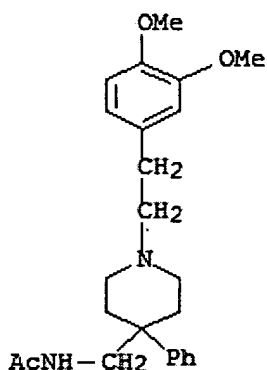
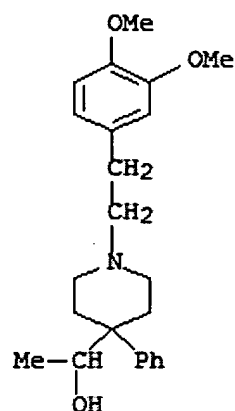
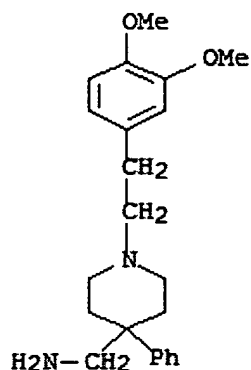
This reads on the compounds when R1 is a phenyl, R5 is also a phenyl substituted by a methoxy, n is 1 and R2 represents (R)2N alkyl and R is a hydrogen. R3 and R4 are also Hydrogen.

See compound in Table II and III of the reference.

Claims 1 and 92 are rejected under 35 U.S.C. 102(b) as being anticipated by Rehse et al 1979 , Neuropsychotropic activity of dopamine –analogous piperidine and piperazine derivative Caplus English Abstract 91:168231.

The reference discloses.

Art Unit: 1625

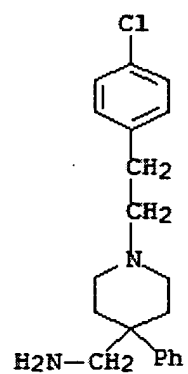
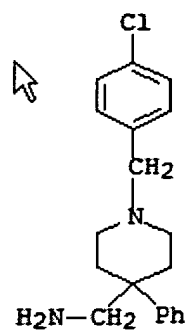
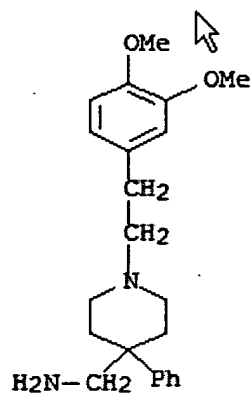


these are compounds with methoxy substitutions on R5 and R1 is phenyl and R2 is ROalkyl or (R)2Nalkyl where R is an Ac or a hydrogen.

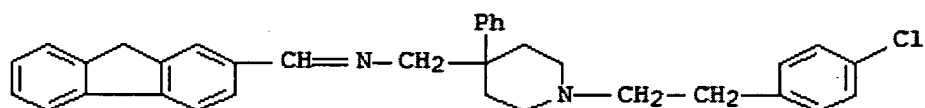
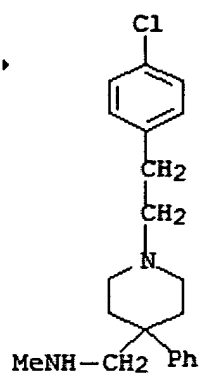
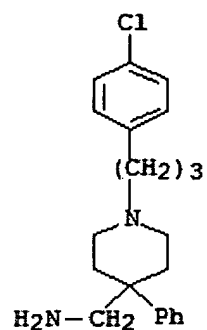
Claims 1 and 92 are rejected under 35 U.S.C. 102(b) as being anticipated by Rehse et al 1986 . Caplus English Abstract DN 106:18327.

The reference discloses

Art Unit: 1625



Art Unit: 1625

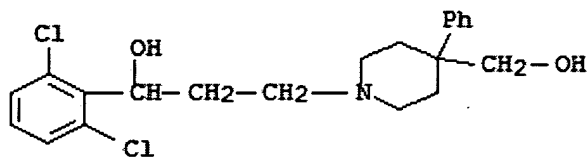


Claims 1 and 92 are rejected under 35 U.S.C. 102(b) as being anticipated by Caplus

English abstract DN 101:191709 Fujisawa Pharmaceutical Co. JP 59106460.

The reference discloses

Art Unit: 1625



Conclusion

Claims 1 and 92 are not found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rita J. Desai
Primary Examiner
Art Unit 1625

R.D.
August 17, 2005